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43. The method of claim 1, wherein said label is member of the group consisting of: printed matter, watermark, magnetic record, semiconductor device, and any combination thereof.

44. The transaction processor of claim 6, wherein said label is member of the group consisting of: printed matter, watermark, magnetic record, semiconductor device, and any combination thereof.

45. The memory medium of claim 11, wherein said label is member of the group consisting of: printed matter, watermark, magnetic record, semiconductor device, and any combination thereof.

46. The method of claim 14, wherein said record is comprises a label that is member of the group consisting of: printed matter, watermark, magnetic record, semiconductor device, and any combination thereof.

Please cancel claims 18-42 without prejudice or disclaimer.

REMARKS

Claims 1-17 and 35-46 are pending in the application. Claims 35-42 have been held withdrawn as being drawn to a non-elected invention. Claims 1-14 have been amended. Claims 18-34 have been canceled without prejudice or disclaimer. Claims 43-46 are newly added. Reconsideration of this application is respectfully requested.

The Office Action has objected to the specification by requiring that each line of the specification be consecutively numbered on each page (pages 11-20). Applicant's attorney is unaware of any statutory provision, Rule of Practice, or requirement in the Manual of Patent Examining Procedure that supports this

requirement. Accordingly, it is submitted that the objection to the specification is without merit and, therefore, that the objection should be withdrawn.

The Office Action rejects claims 1, 6, 11 and 14 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,991,876 to Johnson et al., hereafter Johnson.

This rejection is inapplicable to claims 1, 6, 11 and 14 as amended. Claims 1, 6 and 11 have each been amended to recite the feature of providing a label disposed on a book, the label containing a record that has a plurality of the members of a group of copy items as claimed, and notifying the copy tracker when the label has been disposed on the book. Claim 14 has been amended to recite the feature of the steps of reading a record disposed on a book, the record including a web address of a copy tracker, and using the web address to send a request to copy to the copy tracker. Johnson lacks the aforementioned features. Johnson merely discloses management of copying rights, which, e.g., might be activities of a copy tracker.

For the reason set forth above, it is submitted that the rejection of claims 1, 6, 11 and 14 under 35 U.S.C. 102(b) as anticipated by Johnson is inapplicable and should be withdrawn.

The Office Action rejects claims 18-34 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,629,980 to Stefik et al., hereafter Stefik. This rejection is moot since claims 18-34 have been canceled.

The Office Action rejects claims 2-5, 7-10, 12, 13 and 15-17 under 35 U.S.C 103(a) as unpatentable over Johnson as applied to claim 1 and further in view of the publication, entitled "Big Guide to Netscape Communicator 4", hereafter Big Guide.

The Office Action states that Johnson discloses the limitations of base claims 1, 6, 11, and 14, except that Johnson does not disclose or teach the features of a web address and/or identity information (i) located on the cover of the book or on individual pages thereof, or (ii) in machine readable form. The Office Action cites Big Guide as showing each of these features. The Office Action then concludes that it would have been obvious to one of ordinary skill in the art to get the web address from the book.

This conclusion is inapplicable because the amendments to base claims 1, 6, 11, and 14 have resulted in features that Johnson clearly does not teach or disclose. Namely, Johnson merely discloses a copying management system and does not disclose or teach any method or product that involves preparation of a book itself to have disposed thereon a record that enables a user of the book to simply obtain permission as well as the ability to make a copy of the book or a part thereof. As noted above, Johnson does not provide a label disposed on a book, the record including a plurality of the members of the group consisting of: a title of said book, a web address of a copy tracker for said book, an identity of said order, a first number of copies of said entire book that are permitted to be made, a second number of copies of pages of said book that are permitted to be made and a third number of copies of pictures of said book that are permitted to be made. Also, Johnson does not teach notifying a copy tracker when the label has been placed on the book.

For the foregoing reason, the rejection of claims 2-5, 7-10, 12, 13 and 15-17 under 35 U.S.C 103(a) is inapplicable and should be withdrawn.

There is an additional reason that the rejection under 35 U.S.C. 103(a) is inapplicable. Big Guide, as furnished by the Examiner consists of five pages, numbered by hand. Page 1 is hand labeled as "cover page". Although page 1 has two bar codes and pages 2-4 have none, there is no disclosure or teaching of what data is encoded therein. Page 1 has a web address of

www.sampublishing.com. A visit to this web address revealed that the web site is that of a publishing vendor, which advertises various works that can be ordered online. There is no disclosure or teaching that by going to the web site one can notify a copy tracker of providing a label disposed on a book or of notifying a copy tracker when the label has been placed on the book or can use the web address to send a request to make a copy of the book.

Page 2 of Big Guide contains a prohibition of copying that does not mention any possibility of making copies of Big Guide in whole or in part. The aforementioned lack of teaching and the prohibition of page 2 controverts any suggestion that the web address has anything to do with copying rights management. Accordingly, Big Guide lacks any suggestion or motivation for combination with Johnson.

The Office Action suggestion to use the web address of Big Guide in combination with Johnson is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the additional reason set forth above, it is submitted that the rejection of claims 2-5, 7-10, 12, 13 and 15-17 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action cites a number of patents that were not applied in the rejections of the claims. These patents have been reviewed, but are believed to be inapplicable to the claims.

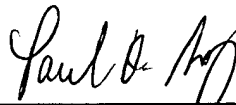
Newly presented claims 43-46 recite that the label is a member of the group consisting of: printed matter, watermark, magnetic record, semiconductor device, and any combination thereof. Neither Johnson, Stefik nor Big Guide teach such a label in the context of their respective base claims. Accordingly, it is submitted that claims 43-46 distinguish from the cited art and are, therefore, allowable.

Attached hereto is a marked-up version of the changes made to the specification and claims by the present amendment. The attachment is captioned "Version With Markings To Show Changes Made."

It is respectfully requested for the reasons set forth above that the objection to the specification be withdrawn, that the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) be withdrawn, that claims 1-17 and 43-46 be allowed and that this application be passed to issue.

Respectfully Submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Application, Serial No. 09/684,207

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Technology Center 2100

IN THE CLAIMS

Please amend the claims as follows:

1. (Amended) A method of filling an order for a right to make copies of a book comprising:

(a) [making] providing a label containing a record [for] disposed on said book, said record including a plurality of the members of the group consisting of: a title of said book, a web address of a copy tracker for said book, an identity of said order, a first number of copies of said entire book that are permitted to be made, a second number of copies of pages of said book that are permitted to be made and a third number of copies of pictures of said book that are permitted to be made; and

(b) notifying a copy tracker that said record has been provided on said book [providing a user of said right with at least said web address; and

(c) sending said record to said copy tracking database].

2. (Amended) The method of claim 1, wherein [step (b) provides] said record includes at least said web address, and wherein said label is provided on a cover of said book.

3. (Amended) The method of claim [2] 1, wherein [step (b) provides said web address] at least a portion of said record is provided on said label in machine readable form.

4. (Amended) The method of claim [3] 2, wherein said at least one portion of said record includes at least one member of the group consisting of: said web address and [step (b) also provides] said identity [on said book cover].

5. (Amended) The method of claim [3] 1, wherein [step (b) also provides] said record includes at least said web address, and wherein said label is provided on one or more pages of said book.

6. (Amended) A transaction processor for filling an order for a right to make copies of a book comprising:

a processing unit and a memory; and

an order procedure stored in said memory, wherein said order procedure includes:

first means for controlling said processing unit to [make] provide a label containing a record of said order, wherein said record includes a plurality of members of the group consisting of: a title of said book, a web address of a copy tracker for said book, an identity of said order, a first number of copies of said entire book that are permitted to be made, a second number of copies of pages of said book that are permitted to be made and a third number of copies of pictures of said book that are permitted to be made, and

second means for controlling said processing unit to [send] notify a copy tracker when said label has been provided on said book [said record to said copy tracking database].

7. (Amended) The transaction processor of claim 6, wherein said order procedure controls said processing unit to provide said web address and said identity of said order on said label, and wherein said label is provided on a cover of said book.

8. (Amended) The transaction processor of claim 7, wherein said web address is [provided on said cover] in machine readable form.

10. (Amended) The transaction processor of claim [9] 6, wherein said record includes at least said web address and said identity, and wherein said label is [are also] provided on one or more pages of said book.

11. (Amended) A memory medium for a computer that fills an order for a right to make copies of a book, said memory medium comprising:

first means for controlling said computer to [form] provide a label containing a record of said order, wherein said record comprises a plurality of members of the group consisting of: a title of said book, a web address of a copy tracker for said book, an identity of said order, a first number of copies of said entire book that are permitted to be made, a second number of copies of pages of said book that are permitted to be made and a third number of copies of pictures of said book that are permitted to be made; and

second means for controlling said processor to [send] notify a copy tracker when said label has been provided on said book [said record to said copy tracking database].

12. (Amended) The memory medium of claim 11, wherein said [memory medium further comprises a third means that] order procedure controls said processing unit to provide [provides] said web address and said identity on said label, and wherein said label is disposed on a cover of said book.

13. (Amended) The memory medium of claim 12, wherein said [web address and identity are] label is also provided on one or more pages of said book.

14. (Amended) A method of making a copy of one or more pages of a book comprising:

(a) [determining] reading a record disposed on said book, wherein said record includes a web address of a copy tracker for said copies of said book;

(b) using said web address to send [sending] to said copy tracker a request to make said copy, said request including an identity of a right to make said copies and an identification of said pages;

(c) obtaining from said copy tracker an electronic image of said pages;
and

(d) making a human readable image of said electronic image.